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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92047262
Party	Plaintiff Roast of the Town, Inc.
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Date	02/08/2010
Attachments	Roast of the Town, Jt Notice of Settlement w Memo 020810.pdf (7 pages)(1180768 bytes)

BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Registration No. 2760766	
Roast of the Town, Inc., Petitioner v. The Smith Agency, Ltd., Registrant.	Cancellation No. 92047262

NOTICE OF SETTLEMENT AND
REQUEST MATTER BE HELD IN ABEYANCE PENDING
FURTHER PROSECUTION OF TRADEMARK APPLICATION

The undersigned parties give notice that they have settled this matter on the terms set forth in the signed Memorandum of Agreement, a copy of which is attached as Exhibit A to this Notice. In accordance with the terms of the parties' settlement, the parties request that this matter be held in abeyance pending further proceedings before the Examiner in Trademark Application Serial No. 78851222.

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Dated: February 8, 2010.

Respectfully submitted,

/Ira M. Schwartz/
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Certificate of Service

I certify that a copy of the foregoing was mailed by first class mail, postage prepaid, upon the following on the date set forth below:

Harold L. Marquis
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600 Galleria Parkway, NW, Suite 1500
Atlanta, GA 30339
Attorneys for Registrant

Dated: February 8, 2010.

/Ira M. Schwartz/

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EXHIBIT A

Memorandum of Agreement

This Memorandum of Agreement memorializes the key terms of a Settlement Agreement entered into by and between Roast of the Town, Inc. ("Roast of the Town") and The Smith Agency ("Smith Agency") with an effective date of January 18, 2010.

1. **Definitions**: The terms set forth below shall be defined as follows.

    a. "'195 Registration" shall mean U.S. Trademark Reg. No. 1601195 issued June 12, 1990 for the Roast of the Town Mark and cancelled on June 22, 2001.

    b. "'222 Application" shall refer to U.S. Trademark Application Ser. No. 78851222 filed March 31, 2006 for the Roast of the Town Mark.

    c. "'546 Application" shall refer to U.S. Trademark Application Ser. No. 76494546 filed March 4, 2003 for the Roast of the Town Mark.

    d. "Cancellation Proceeding" shall refer to that trademark cancellation proceeding now pending before the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office as proceeding number 92247262.

    e. "Roast of the Town Mark" shall refer to the mark ESPRESSIONS used by Roast of the Town in connection with the following goods: fresh roasted coffees, and custom blended coffees and teas, as reflected in the '195 Registration and which was also the subject of the '222 Application and the '546 Application.

    f. "Smith Mark" shall refer to the mark ESPRESSIONE used by the Smith Agency for the following goods: coffee, and which is the subject of the Smith Registration.

    g. "Smith Registration" shall refer to U.S. Trademark Reg. No. 2760766 issued September 9, 2003 for the Smith Mark.

2. **Background**:

    a. Roast of the Town is the owner of the Roast of the Town Mark.

    b. Roast of the Town asserts its Mark has been continuously in use in the United States since August 1, 1989 and has been in use in commerce continuously since August 2, 1989.

    c. Roast of the Town asserts it has continuously used the Roast of the Town mark with the following goods: fresh roasted coffees, and custom blended coffees and teas.

    d. Roast of the Town Mark was previously the subject of U.S. Trademark Reg. No. 1601195 issued June 12, 1990.

e. The '195 Registration was cancelled due to the failure to timely file a renewal application.

f. Roast of the Town thereafter filed a new trademark application for the Roast of the Town Mark on March 4, 2003, as Trademark Application Ser. No. 76494546.

g. The '546 Application was abandoned on January 19, 2005 for failure to timely file a response to an Office Action issued by the U.S. Patent and Trademark Office on June 14, 2004.

h. Roast of the Town asserts it was not timely notified by its counsel of the issuance of the June 14, 2004 Office Action.

i. On March 31, 2006, Roast of the Town filed another trademark application with the U.S. Patent and Trademark Office for the Roast of the Town Mark. This application was assigned Trademark Application Ser. No. 78851222.

j. The Smith Agency is the owner of the Smith Mark which is the subject of U.S. Trademark Reg. No. 2760766 issued September 9, 2003.

k. The Smith Agency asserts it has used the Smith Mark in the United States since at least March 15, 2001.

l. In connection with its '222 Application, Roast of the Town filed the Cancellation Proceeding on March 16, 2007.

m. The parties have resolved their dispute as set forth in the Cancellation Proceeding in accordance with the terms of a written Settlement Agreement between them. This memorandum summarizes the terms of the parties settlement.

3. **Consent to Use and Registration**:

a. The Smith Agency consents to the use and registration by Roast of the Town of the Roast of the Town Mark, as specified in Roast of the Town's '222 Application, which is now pending in the United States Patent and Trademark Office.

b. Roast of the Town consents to the Smith Agency's use of the Smith Mark, as provided in its Smith Registration.

c. The parties acknowledge that their products are sold primarily in wholesale channels to sophisticated business customers, who can readily distinguish each party's goods. Further, the parties sell to different categories of wholesale purchasers: Roast of the Town sells its products primarily to specialty grocery stores, resorts, restaurants and coffee bars; while The Smith Agency sells its products primarily to mass consumer oriented retailers. The parties further recognize and admit that the conditions and restrictions agreed herein will help to distinguish each their respective marks from the others.

d. The parties further agree to take reasonable efforts to prevent any confusion in the future between the Roast of the Town Mark and the Smith Mark. In the event any confusion arises in the future between the Roast of the Town Mark and the Smith Mark, the parties will cooperate with each other to eliminate or minimize such confusion.

e. The parties further note that they have each been using their respective marks in their respective channels of trade since at least as early as March 2001 and they are not aware of any instances of actual confusion between their respective marks. The parties believe this is a substantial period of simultaneous use and that this period of simultaneous use without actual confusion demonstrates that there is not a significant likelihood of confusion between these marks.

4. **Cooperation in Obtaining Registration**. The Smith Agency agrees to cooperate with Roast of the Town, upon its reasonable request, to assist Roast of the Town in obtaining a federal trademark registration for the Roast of the Town Mark, including executing appropriate documents to assist Roast of the Town in obtaining such registration.

5. **Joint Preparation**: This memorandum was prepared and jointly reviewed by legal counsel for all parties. Therefore, in the event that any ambiguity exists in this agreement, this agreement shall not be resolved or interpreted in favor of or against any party based upon which party drafted the agreement

6. **Binding on Successors**: This agreement shall be binding upon and inure to the benefit of the heirs, legal representative, successors and assigns of the respective parties.

7. **Execution of Further Documents**: The parties agree to execute such other and further documents as may be necessary to effectuate this agreement.

8. **Counterparts**: This agreement may be executed in one or more counterparts, each of which shall be deemed an original, but all of which together shall constitute one and the same instrument.

Roast of the Town, Inc.

By _____

Title Pres.

The Smith Agency, Ltd.

By _____ 1/21/10

Title CEO

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